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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,070	12/11/2001	L. Michael Maritzen	SONY 3.0-034	9467
530	7590	09/15/2004	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			HEWITT II, CALVIN L	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 09/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015,070

Applicant(s)

MARITZEN ET AL.

Examiner

Calvin L Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/12/02, 6/5/02, 11/12/02, 3/24/03, 4/17/03
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Status of Claims

1. Claims 1-23 have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 2 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 2 and 20 recite a clearinghouse determining a discount for a consumer, when said consumer purchases goods and services. The Applicant's Specification teaches a bank offering lower rates to users [paragraph 0039] and a clearinghouse broadly determining fees [paragraph 0040]. Therefore, the subject matter of claims 2 and 20 are not supported by the Specification.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 2 recite conditional language (e.g. "in the event", "if"). And, conditional language inherently embodies at least two scenarios, the "if" case and the "if not" case. Claims 1 and 2, however, are silent regarding how the method is to specifically perform if the condition doesn't hold. Therefore, one of ordinary skill is hindered from determining how to use Applicant's method and the scope of said method, regarding claims 1 and 2. For purposes of examination, the Examiner is considering the "if not" case.

Claims 2-7 are also rejected as they depend from claim 1.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Riordan et al., U.S. Patent No. 6,078,891.

As per claims 1 and 2 Riordan teach a method and system for conducting transactions over a network of nodes comprising: receiving a request from a user node for the purchase of goods and services of a merchant (figure 1, items 105 and 107), and determining whether the user is authorized to purchase the goods and services by exchanging information with a bank node. If the purchase is not authorized, Riordan et al. teach transmitting a denial message to the clearinghouse (column 6, lines 9-19).

8. Claims 8-10 and 12-13 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by O'Toole Jr. et al., U.S. Patent No. 6,279,112.

As per claims 8-10 and 12-13, O'Toole Jr. et al. teach a communication device (e.g. PC) comprising: a processing unit with a network connection device (figure 1, item 10) and an agent for compiling transactional history for transmittal through said network connection device (figure 4A). O'Toole Jr. et al. also teach an agent that includes instructions for collecting and storing knowledge related to

the user (abstract; column 9, lines 14-34) and posing questions to the user relating to the user's market purchase decisions (column/line 9/55-10/3).

Regarding claims 9 and 10, the subject matter of these claims only further limits the preamble and a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3-7, 18, and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Riordan et al., U.S. Patent No. 6,078,891 in view of O'Toole Jr. et al., U.S. Patent No. 6,279,112.

As per claims 3-7, 18, and 20-23, Riordan et al. teach a method for performing transactions over a network of nodes comprising a user node (figure

1, items 105 and 107), merchant node (figure 3; column 4, lines 45-48), clearinghouse node (figure 1, item 115) and bank node (figure 1, item 165) and said clearinghouse node transmitting information to the user, merchant and bank nodes (figures 1, 3 and 4; column/line 5/61-6/48). Riordan et al. also teach a clearinghouse instructing a bank node to debit a user's account (column 6, lines 9-33) and transmitting a receipt or denial message (i.e. transaction status) to the user node (column 5, lines 1-54; column 6, lines 9-19 and 36-38). However, Riordan et al. do not specifically recite a clearinghouse receiving user transactional history data with a purchase request. O'Toole Jr. et al. teach a user sending transactional history along with a purchase request (figure 5 and 6; column 9, lines 15-54; column 10, lines 4-38) to a clearinghouse computer and said clearinghouse computer stores said history (figure 4A, item 126). O'Toole Jr. et al. also teach a clearinghouse calculating a purchase price or fees (e.g. sales offer or coupon- "discount rate") for goods and services in response to the received transaction history (column 7, lines 13-23; column 10, lines 10-24). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Riordan et al. and O'Toole Jr. et al. in order to allow a user to get a better offer for goods and services given said user's profile ('112, column 10, lines 12-24).

11. Claims 11 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Toole Jr. et al., U.S. Patent No. 6,279,112 in view of Riordan et al., U.S. Patent No. 6,078,891.

As per claims 11 and 14-17, O'Toole Jr. et al. teach a communication device comprising a processing unit, network connection device and an agent (figure 1, item 10). O'Toole et al. also teach a clearinghouse communicating software updates to an agent (column 9, lines 48-54). However, O'Toole et al. do not specifically recite the communication device coupled to a network comprising a merchant node, a user's bank node and a clearinghouse node. Riordan et al. teach a communication device connected to a network with a merchant node (figure 3; column 4, lines 45-48), clearinghouse node (figure 1, item 115) and bank node (figure 1, item 165). Riordan et al. also teach a clearinghouse node interacting with a bank node for determining whether a user has sufficient funds for obtaining goods and services (figures 1 and 3). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of O'Toole Jr. et al. and Riordan et al. in order to allow users to purchase goods and service obtained from a merchant ('891, figure 3).

12. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Toole Jr. et al., U.S. Patent No. 6,279,112 and Riordan et al., U.S. Patent No.

6,078,891 as applied to claim 18 above, and further in view of Dedrick, U.S. Patent No. 6,151,600.

As per claim 19, Riordan et al. teach a method for performing transactions over a network of nodes comprising a user node (figure 1, items 105 and 107), merchant node (figure 3; column 4, lines 45-48), clearinghouse node (figure 1, item 115) and bank node (figure 1, item 165). O'Toole Jr. et al. teach a communication device purchasing goods and services over a network using an agent (figures 1, 5 and 6). However, neither Riordan et al. nor O'Toole Jr. et al. specifically recite determining a creditor. Dedrick teaches a profile database comprising user demographics such as credit card numbers (column 5, lines 33-43). Dedrick also discloses agents searching a network for goods and services that meet the criteria established by the user profile database (column/line 7/60-8/9) and making automatic purchases when said goods or services are encountered (column 8, lines 27-36; column 9, lines 9-16). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of O'Toole Jr. et al., Riordan et al. and Dedrick in order to expedite user purchases by allowing agents to act on offers, ads or coupons ('112, figures 3-6, column 7, lines 12-23, column 9, lines 31-54; '600, column 8, lines 27-36, column 9, lines 9-16).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Ferguson et al. teach an in-store POS control system with a network that comprises a user node, merchant node, clearinghouse node and bank node
- Off et al. teach instantly redeemable coupons
- Robinson et al. teach digital receipts
- Suzuki teaches a user shopping history stored on a user smart card for dissemination over a network

14. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

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Art Unit: 3621

Washington, D.C. 20231

or faxed to:

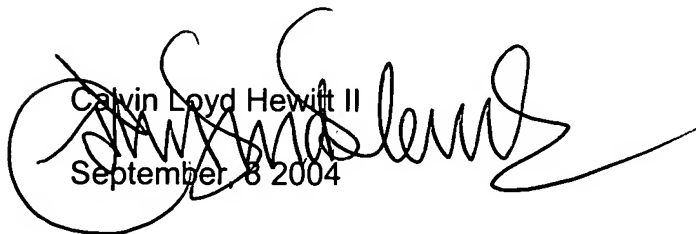
(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.


Calvin Loyd Hewitt II
September 8 2004